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10/036,275	10/24/2001	William D. Tierney	M1103.70260US00	3532

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EXAMINER

TANG, KAREN C

ART UNIT	PAPER NUMBER
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2151

MAIL DATE	DELIVERY MODE
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12/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/036,275

Applicant(s)

TIERNEY ET AL.

Examiner

Karen C. Tang

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11-19, 24-39 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-19, 24-39 and 41-46 is/are rejected.
- 7) ☒ Claim(s) 7-10, 20-23, 27-39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

- This action is responsive to the amendment and remarks file on 10/30/07.
- Claims 1-39, 41-46 are presented for further examination.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-39, 41-46 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention Claims 27-39 are directed to non-statutory subject matter.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and func-

tionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

According to Applicant’s own specification, the computer readable media could be microwave, infrared or series of computer instructions embodies all or part of the functionality.

Therefore, does not satisfy any of the four statutory categories, and is indeed not tangible.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-39 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 contains preamble "...that when executed...perform a method" is indefinite since scope/metes and bounds are not being defined. The term "When" is not requirement that it is performed, and therefore it renders body of claim moot.

Further, "comprising acts of" does not describe who and what is performing these steps, "methods"? or "instructions" or "computer readable medium".

Claims 1-39, 41-46 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 14, 27 and 41 contains limitations which is unclear, "wherein the exchanged management information comprises at least one member of a group comprising a license file and a policy restriction file, and the interacting comprises: if the exchange information includes a license file...if the exchange information includes a policy restriction file". The limitations in the claims are ambiguous. First, the limitations appears as the management information comprises license file AND a policy restriction file. However, applicant then put in a conditional terms such as "if", which makes the limitations appears as the management information comprises license file OR a policy restriction file.

For the examine purpose, the limitation is interprets as "the management information comprises license file or a policy restriction file".

Since for the examine purpose, the management information comprises only the license file, the limitation "if the exchanged information includes a policy file" is not requirement that it is performed, and therefore it renders the body of claim moot.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11, 13-18, 24, 26, and 41-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flowers, Jr. et al hereinafter Flowers (US 2003/0105812) in view of Nguyen (US 2007/0136817).

1. Referring to Claims 1, 14, and 41, Flowers disclosed

(a) using client software (refer to 0173) operating in a first device and a second device to connect a first user of the first device (user's PC refer to 0056) to a second user of the second device (PDA, refer to 0056), in a peer-to-peer collaboration session (peer-to-peer session, refer to 0062) including the first user and second user without an intervening server (refer to 0053), the first user having a first collaboration identity in a shared space and the second user having a second collaboration identity in the shared space (each user has two identify, one is its IP address, and another one is called a magic number, refer to 0157 and 0155).

(b) sending a request from the management server to the first user to become a managed entity (server sends a request to a computer B, refer to 0174);

(c) downloading from the management server to the client software operating in the first device a definition file containing a definition of the managed entity (a list of community members, refer to 200), and

(d) associating a management identity in the definition file with the first collaboration identity or first device information in the client software operating in the first device in order to create the managed entity, the managed entity being different than the first collaboration identity, the management identity allowing the first user or first device to be identified by the management server (it allows the server to see the device's presences, refer to 0200); and

(e) interacting, between the management server and the client software using the management identify (refer to 0200), to exchange management information separately from the collaborative information exchanged between the first user and the second user (refer to 0200 and 0201).

Although Flowers disclosed the invention substantially as claimed, Flowers is silent regarding wherein the exchanged management information comprises at least one member of a group comprising a license file and a policy restriction file;

(f) if the exchanged information includes a license file, in response to information in the license file, enabling at least one function in the client software;

Nguyen, in an analogous art disclosed wherein the exchanged management information comprises at least one member of a group comprising a license file or a policy restriction file (license file, refer to 0092);

(f) if the exchanged information includes a license file, in response to information in the license file, enabling at least one function in the client software (enable games on the device, refer to 0092);

Hence, providing functionalities disclosed by Nguyen, would be desirable for a user to implement in order to keep in track of the licensing in the peer-to-peer environment.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Flowers by including the features presented by Nguyen.

2 Referring to Claims 2, 15, and 42, Flowers disclosed wherein the managed entity is a managed user (peer to peer, managed by the server, refer to 0062) and the definition information file is an injectible identity file (a list of community members in a file, refer to 200) and the act (d) of associating comprises incorporating information from the injectible identity file into a user account file (it is obvious that after user has enter their information refer to 0063, the definition information file that the user gathered from server will be associated with the user account information).

3. Referring to Claims 3, 16, and 43, Flowers disclosed wherein the managed entity is a managed device (peer to peer, managed by the server, refer to 0062) and the definition file is a device information file (a list of community members in a file, refer to 200).

4. Referring to Claims 4, 17, and 44, Flowers disclosed wherein act (d) if associating comprises incorporating information from the device file into a Windows REG file (it is inherent that

Windows Operating System provides the Windows Reg Files, 0121, also, it is obvious that after user has enter their information, the definition information file that the user gathered from server will be associated with the user account information)

5. Referring to Claims 5, 18 and 45, Flowers discloses (i) sending at least one license file from the management server to the managed user (refer to 0105);

Although Flowers disclosed the invention substantially as claimed, Flowers is silent regarding wherein the exchanged management information comprises at least one member of a group comprising a license file and a policy restriction file;

(f) if the exchanged information includes a license file, in response to information in the license file, enabling at least one function in the client software;

Nguyen, in an analogous art disclosed wherein the exchanged management information comprises at least one member of a group comprising a license file or a policy restriction file (license file, refer to 0092);

(f) if the exchanged information includes a license file, in response to information in the license file, enabling at least one function in the client software (enable games on the device, refer to 0092);

Hence, providing functionalities disclosed by Nguyen, would be desirable for a user to implement in order to keep in track of the licensing in the peer-to-peer environment.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Flowers by including the features presented by Nguyen.

6. Referring to Claims 11 and 24 Flowers disclosed wherein the management information comprises event notifications and statistical information and interacting to exchange management information comprises: (i) periodically receiving event notifications and statistical information from the client software of the managed user to the management server (refer to 0195).

7. Referring to Claims 13 and 26, Flowers disclosed wherein event notifications and statistical information are temporarily stored in a memory located at a client site (the notification has to stored in the memory).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 12, 19, 25, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flowers et al hereinafter Flowers (US 2003/0105812) in view of Nguyen (US 2007/0136817) in further view of Russel et al hereinafter Russel (US 2002/0069420)

9. Referring to Claims 6, 19 and 46, although Flowers and Nguyen disclosed the invention substantially as claimed, Flowers is silent regarding i) sending at least one policy restriction file from the management server to the managed user; and
ii) in response to information in the policy restriction file, restricting at least one function in the client software.

Russell, in an analogous art disclosed a system that deliver content over a network in the peer-to-peer situation where suggest regarding i) sending at least one policy restriction file from the management server to the managed user (refer to 0026, 0037); and
ii) in response to information in the policy restriction file, restricting at least one function in the client software (refer to 0105).

Hence, providing the methods as disclosed by Russell, would be desired for server providing the restriction file so that the users are forced to follow the policy.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the systems of Flowers and Nguyen by including the features which allows the user to be restricted while accessing the system in order to provide privacy and forced the users to follow the policy.

10. Referring to Claims 12 and 25, although Flowers and Nguyen are silent regarding wherein the event notifications include error notification.

Russell, in an analogous art disclosed wherein the event notification wherein the event notifications include error notification (refer to 0107);

Hence, providing the methods as disclosed by Russell, would be desired to provide a error notification that include error notification since in the case when the license expired would require user to update the newest license.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the system of Flowers and Nguyen and by including the features which provide the error notification in the system in the case when the file is expired.

Allowable Subject Matter

Claims 7-10, 20-23, and 28-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, and 35 U.S.C 101, set forth in this Office action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).

Stefan "Data management System and method for replicated data" disclosed data management system and method for managing copies of a shared data file maintained on a plurality of computer systems that are connectable via a mobile communications network.

Teibel "Chat distribution service system for alternatively delivering the url linked to a message determined by the chat client device to be unsuitable for distribution" disclosed a method of sending messages from a first chat client in a chat group to multiple other clients in the chat group comprises storing a first message on a first server, the first message not suitable for efficient multiple distribution from the first client to the other clients.

Huitema et al "Peer-to Peer group management and method for maintaining peer-to peer graphs" disclosed a system and method of serverless peer-to-peer group management and maintenance is presented.

Sutherland et al "Peer-to-Peer enterprise storage" disclosed a storage coordinator that centrally manages a distributed storage resources in accordance with system policies administrated through a central administrative console.

Barnier et al "Web based extranet architecture providing applications to non-related subscribers" disclosed a network which couples a plurality of non-related participants and a server coupled to the network.

Bunney et al "Notification subsystem" disclosed a method and a network that allow users to share information with each other and with the at least one server.

Zhu et al "Quality of service maintenance for distributed collaborative computing" disclosed a computer system providing a plurality of servers computers interconnected via a high-speed link.

Decasper et al "Personalized content delivery using peer-to-peer preacaching" disclosed a method and apparatus for peer-to-peer video precaching.

Nandhra "Method and system for co-joining computational spacecells in a networked environment" disclosed a system, method, and apparatus providing the creation management and usage of a non-distributed computational and storage space environment in the field of networked device.

Ozzie et al "Method and apparatus for generating data change requests containing data consistency information in a peer-to-peer collaborative computer system", disclosed system employs a data change request priority scheme for determining an order of execution of data change requests in effective changes to local copies of data so as to optimize data consistency for collaborative activities.

Examiner's Notes: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the

specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KT



JEFFREY PWU
SUPERVISORY PATENT EXAMINER